

REMARKS/ARGUMENTS

Responsive to the Office Action mailed May 10, 2005:

I. NON-PRIOR ART MATTERS

- A. The Office Action rejected claims 28, 29, 31-34, 36, 37, 46, 47, 49-52, 54 and 55 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The Office Action states “Claims 28 and 46 have been amended to apply the word “fully” to the phrase ‘engage the side wall.’ No support is found in the original disclosure for such a distinction.”

Applicant respectfully disagrees. The original disclosure includes the claims, Specification, and drawings. Figs. 8 and 9 show that the outermost member 142 fully engages the side wall 122 of the mixer. Page 18, paragraph 2 of the Specification states:

The outer most lower mixing member 140 preferably slides along the side wall 122 as the lower rotating member 134 is rotated to thereby reduce accumulation of slurry on the side wall 122. (emphasis added)

Page 16, paragraph 3 states:

The paddle system 130 has a self cleaning configuration to facilitate removing all of the slurry from the slurry mixer 120 at the end of each work day. The self cleaning capability thereby minimizes the time and effort needed to clean the slurry mixer 120 and assures complete slurry removal from the slurry mixer 120. (emphasis added)

Taken together, Fig. 8 and the two cited paragraphs from the Specification provide adequate disclosure of the term “fully engages” in the original disclosure. The fact that the member 140 slides along the side wall while at the same time assuring complete slurry removal must mean that the member 140 fully engages the side wall. Furthermore, Fig. 8 shows this expressly.

- B. The Office Action rejected claim 26 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action states:

Claims 28 and 46 have been amended to apply the word “fully” to the phrase “engage the side wall.” It is unclear what distinction applicant intends. The Specification provides no assistance in determining what is or is not full engagement in the context of the limitation.

Again, Applicant respectfully disagrees. Figure 8 and the above-cited sections of the Specification fully support the language of the amended claims.

Claims 36 and 54 have been amended as suggested in the Office Action.

II. PRIOR ART MATTERS

A. The Office Action rejected claims 28, 29, 31-33, 36, 37, 46, 47, 49-51, 54, 55, 56, and 58-60 under 35 USC 102(b) as being anticipated by McCleary. Applicant respectfully traverses this rejection.

A single prior art reference anticipates a claimed invention only if it discloses each and every claim element.¹

As to claim 28, McCleary does not disclose: at least one of the lower mixing members fully engaging the side wall as the second stirring apparatus is rotated to remove slurry from the side wall. As seen in Fig. 2 of McCleary, there is a relief 25 between the teeth 26 and the wall 24 in the 55 degree arc of rotation. Thus, the teeth 26 do not fully engage the wall 24. The importance of the difference has been previously pointed out at page 18 of the Amendment filed April 1, 2004.

The Office Action states:

...and wherein at least one of the lower mixing members fully engage the side wall as the second stirring apparatus is rotated to remove slurry form the side wall (see Fig. 1, col. 2, lines 53-57, col. 4 line 50 to col. 4, line 9).

Applicant respectfully disagrees.

As pointed out in the previous Amendment and Response, col. 3 line 75 to col. 4 line 9 specifically disclose, in combination with Fig. 2, that the teeth 26 do not fully engage the side wall 24 because the wall 24

¹ *Structural Rubber Prod. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984)

spirals outwardly by receding gradually from the circular path of the rotor ring 22 to form a relief 25, defined by the diverging wall 24 and the disc ring 22, into which the slurry moves prior to entering port 20 of vertical conduit 14 in the manner also seen in Fig. 2. The shape of the teeth 26 is such that their edges 27 tend to force the slurry into the relief 25 as the rotor ring moves about its path.

Fig. 2 shows that the relief 25 separates the teeth 26 from the wall 24 even at the closest approach.

The Office Action also states:

Note also that applicant expressly admits on page 18, lines 11-12 of the 05 April 2004 communication that “the teeth [of McCleary] serve to scrape the slurry along the wall.”

However, Applicant did not state that the teeth of McCleary fully engage the wall. Instead, the previous citation continues:

...but it does not remove the slurry from the entire wall (55° arc of the circular mixer wall diverges and is not scraped, resulting in greater than 15% of the wall not being completely cleaned. (emphasis added)

McCleary further demonstrates that it is possible to scrape the slurry along the wall without fully engaging the wall.

Further, many instances are known where a blade “scrapes” something along a surface without fully engaging the surface, for example, in the use of a putty knife to apply putty to a surface or the use of a taping knife to apply mortar to the joints of gypsum (wall) board. In such applications, as in McCleary, the intent of the blade is not to clean the surface of the material, but to apply the material along the surface (the relief in the case of McCleary). This is not the intent of the present application.

Claims 28 and 46 are thus allowable.

The other rejected claims contain additional elements or limitations beyond an allowable independent claim and are also allowable.

Further as to claims 29 and 56, McCleary does not disclose wiping slurry from the lower support member with the upper mixing members. As seen in Fig. 1, the pins 18a etc.

of McCleary do not come close to the lower support 17. Applicant pointed this out in the previous communication, to which the Examiner has not responded.

- B. The Office Action rejected claims 28, 29, 31-33, 36, 37, 46, 47, 49-51, 54, 55, 56 and 58-60 under 35 USC 103(a) as being unpatentable over McCleary. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.² If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.³

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁴

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The reference does not teach or suggest all the claim limitations, specifically that the lower mixing members fully engage the side wall.

The Office Action states:

...in the alternative one might argue that one or more of the scraping/engaging functions or steps is not sufficiently disclosed, it is considered that the statement in col. 2, lines 53-67 [of McCleary] that an object of the invention is to produce a 'self-cleaning' apparatus would have suggested that the clearances of the relevant parts be sufficiently claims [sic] for scraping to occur.

Although Applicant cannot fully determine the meaning of this text because of the confusing language, Applicant disagrees with what is apparently being stated. Col. 2 lines

²MPEP Sec. 2142.

³ Id.

⁴Id. (emphasis supplied)

53-57 state that the apparatus "is substantially self-cleaning." There is no suggestion of the teeth fully engaging the wall of the mixer.

Applicant pointed out the differences between McCleary and the present invention in the communication of April 5, 2004 at page 18, to which Applicant again directs the Examiner's attention.

The dependent claims contain additional elements of limitations beyond their corresponding independent claim and are also allowable.

- C. The Office Action rejected claims 34 and 52 under 35 USC 103(a) as being unpatentable over McCleary. Applicant respectfully traverses the rejection.

Claims 34 and 52 contain additional elements or limitations beyond their corresponding allowable independent claims and are also allowable.

New claim 61 is also allowable over the cited prior art. It is supported in the original disclosure by Figs. 8 and 9.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Respectfully submitted,

Dated: 10 Nov 05

By: 

Gerald E. Helget (Reg. No. 30,948)

Nelson R. Capes (Reg. No. 37,106)

BRIGGS AND MORGAN, P.A.

2200 IDS Center

80 South Eighth Street

Minneapolis, MN 55402

Telephone: (612) 977-8480